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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,036	06/18/1999	PATRICK M. SCHLIEVERT	600.347US11	7188

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EXAMINER

HINES, JANA A

ART UNIT PAPER NUMBER

1645

DATE MAILED: 10/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/336,036

Applicant(s)

SCHLIEVERT ET AL.

Examiner

Ja-Na A Hines

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-10 and 17-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10 and 17-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Amendment Entry

1. Amendments have been entered as filed on 11 June 2002. Claims 1, 4-6, 8, 10, 17 and 19 have been amended. Claim 3 has been cancelled. Claims 20-42 have been newly added. Claims 1, 4-10, 17-42 are under consideration in this office action.

Drawings

✓2. Figure 1 refers to a sequence without sequence identifying numbers being described within the figure itself or the brief description of the drawings within the specification. Therefore, appropriate correction is requested.

Response to Arguments

3. Applicant's arguments filed 11 June 2002 have been fully considered but they are not persuasive.

The rejection of claims 1, 4-10, 17-19, 27-28 and 32-42 under 35 U.S.C. 112 first paragraph is maintained. The specification does not reasonably provide enablement for a Streptococcal pyrogenic exotoxin type C (SPE-C) mutant with three, four or five mutations at the recited positions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Applicants' amendments to the claims do not address the enablement issues in the claims and newly added claims 27-28 and 32-42. There are no examples that teach

three, four or five substitutions at each of the recited positions. Thus if each recited position is substituted with any amino acid and in any combination of substitutions there would be an infinite number of possible combinations. Furthermore, there are no examples using histidine-35 in combination with other amino acid substitution. The specification only provides guidance to specific amino acids and does not teach any amino acid substitution may be changed without causing a detrimental effect to the SPE-C toxin to be produced. The claims recite a mutant that can be obtained by substituting one to five amino acids at positions 12, 15, 17, 35 or 38, if all five of the recited amino acid positions are substituted, the resulting mutant SPE-C could result in a mutant toxin not taught or enabled by the specification. New claims 27-28 and 32-42 comprises triple mutants, yet there is no support for such. Furthermore, the claims do not recite whether the substitution will to be a conservative substitution. The specification does not teach using a mutant with three or more substituted positions. There are no representative examples of mutant toxins with the recited mutations. Accordingly, one of skill in the art would be required to perform undue experimentation to use any amino acid at any location to produce a stable SPE-C toxin. Therefore, one skilled in the art could not make and/or use the invention without undue experimentation. Thus the rejection is maintained.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1, 4-10, 17-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims refer to amino acid substitutions without referring to a basic sequence which is being substituted. Therefore applicant is asked to recite the base amino acid sequence that is being used as the template for said substitutions.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is (703) 305-0487. The examiner can normally be reached on Monday through Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Ja-Na Hines 

October 8, 2002


MARK NAVARRO
PRIMARY EXAMINER